

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION

OF: MÖHWALD ET AL.

SERIAL No. 09/674,541

FILED: NOVEMBER 02, 2000

FOR: COMPOSITION SUITABLE FOR ELECTROCHEMICAL CELL

RECEIVED
MAY 05 2003
GROUP 1700

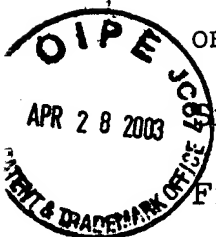
Box:

Petition/AF

CONFIRMATION No.: 8978

GROUP ART UNIT: 1745

EXAMINER: LAURA S. WEINER



I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231, on:

April 24, 2003

Date of Deposit

Herbert B. Keil

Person Making Deposit

Signature

April 24, 2003

Date of Signature

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

RECEIVED

MAY 01 2003

OFFICE OF PETITIONS

PETITION UNDER 37 C.F.R. §1.181

Sir:

Applicants hereby petition to the Honorable Commissioner to withdraw from final rejection the above-identified pending application and require the Examiner to provide a non-final action which is complete as to all matters of patentability.

On the facts which are summarized below, applicants respectfully suggest that their amendment dated October 16, 2002 (date of the Certificate of Mailing; Paper No. 06) did not necessitate new grounds of rejection which were raised by the Examiner in the final Office action of December 04, 2002 (Paper No. 07), and thus the Office action asserting such new grounds should be a non-final rejection to provide applicants with a full and fair time period to respond to such new grounds of rejection.

SUMMARY OF MATERIAL FACTS:

1. The application was filed in the U.S. pursuant to the provisions of Section 371 of the Patent Act on November 02, 2000.

2. A first written action in the application issued on the merits of the claimed subject matter on June 19, 2002 (*Paper No. 05*). In the Office action the Examiner rejected all of applicants' claims (*Claims 14 to 29*) under 35 U.S.C. §112, ¶2, as being indefinite. Additionally, Claims 23 and 24 were rejected as unpatentable under 35 U.S.C. §101.

3. On October 16, 2002 (*date of Certificate of Mailing; marked as Paper No. 06*), applicants submitted a reply under Rule 111 which included remarks addressing the Examiner's rejections, and an amendment canceling Claims 15 to 17 and 29, and revising the wording of Claims 14 and 18 to 28.

4. The Examiner issued a second Office action on the merits on December 04, 2002 (*Paper No. 07*), and made the Office action final. In the final Office action the Examiner maintained the rejection under 35 U.S.C. §112, ¶2, concerning Claims 14 and 18 to 28, asserting that any new ground of rejection was necessitated by applicants' amendment.

5. On April 04, 2003 (*date of Certificate of Mailing; marked as Paper No. 09*), applicants submitted a reply under Rule 116 addressing the Examiner's reasons for maintaining the rejection under 35 U.S.C. §112, ¶2, and seeking entry of further amendments in the claims. Additionally, applicants requested withdrawal of the finality of the Office action submitting reasons why the finality was deemed to be premature.

6. The Examiner issued an advisory action on April 16, 2003 (*Paper No. 10*). The Examiner indicated that the proposed amendments would not be entered. The Examiner did not specifically address applicants' request for withdrawal of the finality of the previous Office action. However, the Examiner's advisory action implies that the finality of the Office action will be maintained.

7. This Petition follows.

M E M O R A N D U M

It is applicants' position that the amendment dated October 16, 2002 (date of Certificate of Mailing; marked as Paper No. 06) did not necessitate the new grounds of rejection which were raised by the Examiner in the final Office action, and that the finality of said Office action with such new grounds is thus improper.

In the first Office action (mailing date June 19, 2002), the Examiner indicated that Claim 14 was unclear because "*it is unclear how a pigment material can act as a cathode or anode material*" (Paper No. 05, page 2, lines 11 and 12). However, no objection was raised against applicants' wording

- "a compound Ib which acts as a cathode material" in Claim 16¹⁾, or
- "a compound Ia which acts as an anode material" in Claim 17²⁾.

Accordingly, applicants amended Claim 14 to remove the reference to a pigment, and applicants' introduced the wording of Claims 16 and 17 into Claim 14. In the second and final Office action (mailing date December 04, 2002), however, the Examiner took the position that the language carried over from Claims 16 and 17 renders the claimed subject matter indefinite (Paper No. 07, page 3, lines 2 to 6). Since applicants' amendment merely entered the wording previously found in Claims 16 and 17 into Claim 14, and the respective wording was not previously indicated by the Examiner as objectionable under Section 112, ¶2, this new ground of rejection cannot reasonably be deemed to be necessitated by applicants' amendment.

In the first Office action, the Examiner nowhere indicated that applicants' reference to a solid material in the claims as "*a solid*" or "*the solid*"³⁾ renders the claims indefinite. However, in the second and final Office action, the Examiner criticizes that "*[i]t is unclear what is meant by 'by weight of a solid (I)'. A solid what?*" (Paper No. 07, page 2, lines 17 and 18). Applicants' amendment merely makes use of language which was not deemed objectionable in the Ex-

-
- 1) The Examiner's reasons concerning Claim 16 are set forth on page 3, lines 1 to 6, of Paper No. 05.
 - 2) The Examiner's reasons concerning Claim 17 are set forth on page 3, lines 7 to 11, of Paper No. 05.
 - 3) The expression "*a solid*" or "*the solid*" is used in original Claims 14 to 18 to characterize component (Ia).

aminer's initial rejection of the claims under Section 112, ¶2. This new ground of rejection which was raised by the Examiner in the second and final Office action, therefore, cannot reasonably be taken as having been necessitated by applicants' amendment.

The Examiner initially argued that applicants' Claims 27 and 28 were unpatentable under Section 112, ¶2, because it was unclear how an electrochemical cell could comprise a solid electrolyte or separator (Paper No. 05, page 4, lines 1 to 4). The Examiner did not, however, criticize the phrase "*as claimed in claim ... or a combination of two or more thereof*" in the initial rejection. In the second and final Office action the Examiner points to the phrase "*defined in claim ... or a combination of two or more thereof*" as rendering the subject matter of Claims 27 and 28 indefinite (Paper No. 07, page 3, lines 11 to 14). The only change which was effected by applicants in the phrase in question is editorial and concerns the replacement of "*as claimed*" by "*defined*". It is not seen how this editorial change in the referenced phrase could possibly be deemed to have necessitated the Examiner's new ground of rejection.

In light of the foregoing, the pertinent facts in the present case fail to support the Examiner's assertion in the final Office action that the new ground of rejection was necessitated by applicants' amendment in Paper No. 06. In light of the Examiner's indication that entry and consideration of applicants' reply dated April 04, 2003 (Paper No. 09) is denied, and the implication that the finality of the Office action of December 04, 2002 (Paper No. 07) will be maintained, applicants have been denied a full and fair opportunity to argue or suitably address the rejection under Section 112, ¶2.

C O N C L U S I O N

Applicants therefore respectfully request that the finality of the Examiner's action dated December 04, 2002, be withdrawn and that the application be returned to the Examiner for entry and full consideration of applicants' reply dated April 04, 2003, as a timely reply under Rule 111. Favorable action is respectfully solicited.

REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a second one month extension of time be granted in this case. A check for the \$300.00 fee is attached. A request and fee for a first one month extension of time was submitted along with applicants' reply dated April 04, 2003 (date of the Certificate of Mailing; Paper 09).

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees to Deposit Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

KEIL & WEINKAUF



Herbert B. Keil

Reg. No. 18,967

1350 Connecticut Ave, N.W.
Washington, D.C. 20036
(202) 659-0100

HBK/BAS